

Art Unit: 1786

### **DETAILED ACTION**

1. Applicant's amendment and accompanying remarks filed June 17, 2011 are acknowledged.
2. Examiner acknowledges amended claims 10 and 14.
3. The rejection of claims 1-2, 4-14, 16 and 18-24 under 35 U.S.C. 102(a) as being anticipated by Espiard et al., WO 2004/007395 with U.S. Patent Number 7,887,908 used as the English equivalent is overcome by applicant's submission of the certified translated copy of the foreign priority document.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 1786

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-2 and 4-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7-14 of U.S. Patent No. 7,887,908. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in both the present application and the patented reference recite an aqueous sizing composition comprising a water dispersible epoxy resin; an amine hardener, a silane coupling agent and an imidazole. Additionally, the claims in both the present application and the patented reference recite that the resin has an epoxy equivalent weight of between 150 and 2000. Also, the claims in both the present application and the patented reference recite that the amine hardener can be an aliphatic amines or cycloaliphatic amine. The claims in both the present application and the patented reference recite that the sizing composition comprises a silane and mineral oil. The claims in the present application and the patented reference recite a process where the sizing composition is sprayed onto the fibers. Also, the claims in both the present application and the patented reference recite an insulation product comprising a web of mineral wool (glass fibers) and at least 1% by weight of a binder, obtained from a sizing composition

Art Unit: 1786

wherein the grammage of the web of mineral wool is between 10 and 300 g/m<sup>2</sup>. The patented reference does not disclose how the epoxy resin is prepared. However, the preparation of the epoxy resin is not given any patentable weight.

### ***Response to Arguments***

6. Applicant's arguments with respect to the present claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CAMIE THOMPSON whose telephone number is (571)272-1530. The examiner can normally be reached on Monday-Friday 8:00 am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer Chriss can be reached on 571-272-7783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1786

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CAMIE THOMPSON/  
Examiner, Art Unit 1786